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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,180	09/29/2000	David Suda	192400US55X	2909

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EXAMINER

RHEE, JANE J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 08/06/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/675,180

Applicant(s)

SUDA ET AL.

Examiner

Jane J Rhee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-14, 19-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 11-14, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

NEW REJECTIONS

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. The term "adapted to" in claim 11 is a relative term which renders the claim indefinite.

The term "adapted to" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 11-13 are rejected under 35 U.S.C. 102(b) as being unpatentable by Knapp et al. (5685938).

Knapp et al. discloses a backing sheet for insulation, the backing sheet comprising: a first side having an adherent material thereon (figure 4 number 30 and 34), the first side and the adherent material being adapted to receive a sheet of fiberglass material (figure 4 number 34 and 52); a second side; a stapling tab extending along an edge of the backing sheet (figure 4 number

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32), the stapling tab having a first portion of the second side positioned against a second portion of the second side (figure 4 number 42); and a tacky substance bonding the first portion of the second side and the second side portion of the second side (figure 4 number 34). Knapp et al. discloses that the stapling tab comprises a first fold extending along an edge of the backing sheet the first fold having a first portion of the first side bonded to the second portion of the first side by the adherent material (figure 4 number 42 and 34); and a second fold extending along the edge of the backing sheet contiguous with the first fold, the second fold having the first portion of the second side positioned against the second portion of the second side (figure 4 far left part of 32). Knapp et al. discloses that the tacky substance is located on the backing sheet in an area extending inward from an edge of the first fold by a predetermined width (figure 4 number 42 and 34).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 19-20 are rejected under 35 U.S.C. 102(e) as being unpatentable by Jorgenson et al.

Jorgenson et al. discloses a backing sheet comprising a first side having an adherent material thereon (figure 10 number 202); a second side; a stapling tab extending along an edge of the backing sheet (figure 10 number 208), a stapling tab having a first portion of the second side positioned against a second portion of the second side (figure 10 number 220'); and at least one hold^e extending through the backing sheet such that a portion of the adherent material extends through at least one hold^e and contacts the second side (col. 7 line 11-12). Jackson et al. discloses a first fold extending along an edge of the backing sheet, the first fold having a first portion of the first side positioned against a second portion of the first side (figure 10 number 220') and a second fold extending along the edge of the backing sheet contiguous with the first fold, the second fold having the first portion of the second side positioned against the second portion of the second side (figure 10 number 220).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knapp et al. in view of Bose et al. (4952441).

Knapp et al. discloses a tacky substance (col. 3 line 58-60). Knapp fail to disclose that the tacky substance is a starch solution (col. 3 lines 44-50) for the purpose of exhibiting the desired dead fold characteristic without any significant undesired spring back of the tabs relative to the insulation layer (col. 3 lines 44-50).

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided Knapp with a tacky substance that is a starch solution in order to exhibit the desired dead fold characteristic without any significant undesired spring back of the tabs relative to the insulation layer (col. 3 lines 44-50) as taught by Bose et al.

Response to Arguments

5. Applicant's arguments with respect to claims 11-14 and 19-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane J Rhee whose telephone number is 703-605-4959. The examiner can normally be reached on M-F.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-301-9999 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Jane Rhee
August 5, 2002



HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

8/5/02